REMARKS

Claims 1-2, 4-12, 14-20, and 22-34 are pending. Reconsideration of pending claims 1-2, 4-12, 14-20, and 22-34 is respectfully requested in light of the following remarks.

Rejections Under 35 U.S.C. §103(a), Claims 1-2, 4-12, 14-20, and 22-31

Claims 1-2, 4-12, 14-20, and 22-31 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Shavit in view of a newly cited reference by Banks et al. (US Patent Publication No. 2002/0161672 hereinafter referred to as "Banks"). Applicants traverse this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claims 1-2, 4-12, 14-20, and 22-31.

As the PTO recognizes in MPEP § 2142:

> *... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The Shavit and Banks references cannot be applied to reject claims 1-2, 4-12, 14-20, and 22-31 under 35 U.S.C. § 103(a), which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, neither Shavit nor Banks, either alone or in combination, discloses

or suggests "receiving the product manufacturing facility order that identifies at least the first product and desired quantity, retrieving a mapping database record associated with the first product from the mapping database, and calculating an order price based on the mapping database record comprising the quote amount associated with the first product, and the desired quantity identified in the product manufacturing facility order," as recited in claim 1.

The examiner admits that Shavit does not disclose such features, but alleges that Banks discloses these features in paragraphs 12, 18-20, and 22 and in Fig. 1, which is shown below:

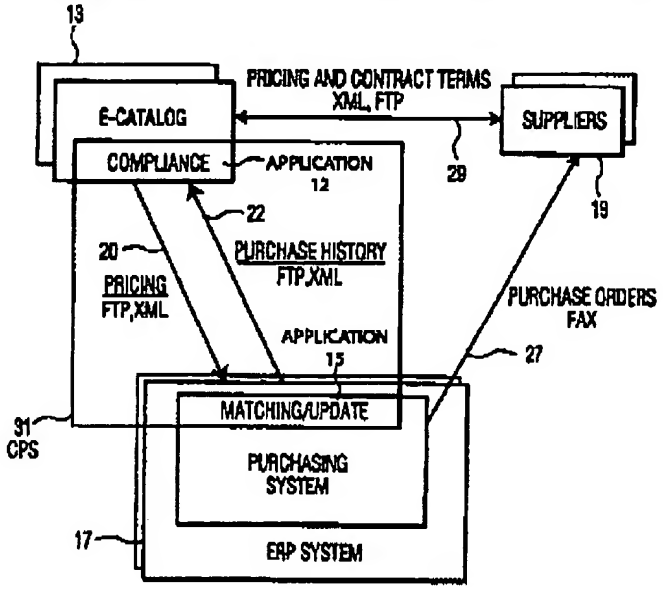


FIG. 1

In the above paragraphs and Fig. 1, Banks discloses that "[t]he purchasing system 17 receives an initial download of purchasing contract, pricing, and associated data 20 comprising data held in the e-catalog 13 database. . . .Purchasing system 17 provides procurement database purchase history data 22 to e-catalog database system and e-catalog 13 uses this history data in recalculating pricing and in identifying off contract purchases and incorrect pricing performed by unit 17. . . .System 31 synchronizes price, vendor, product and other information between the

unit 13 and 17 databases once a Catalog file from the e-Catalog unit 13 is received and loaded into a set of cross reference (data mapping) tables in the unit 17 database. This synchronization is achieved by matching information items received from unit 13 with corresponding items in unit 17 using the mapping tables and replacing matched items with updated information." In paragraphs 31 and 32, Banks discloses that "[a]pplication 12 in step 315 processes the received product usage information to identify incorrect prices, recalculate purchase pricing of products in the product usage information, identify purchase contractual discrepancies, and identify items not covered by a purchase contract. . . . Application 12 in step 320 updates product information in the e-Catalog system 13 database based on the received product usage information. . . .E-Catalog system 13 uses product usage information to recalculate item price information provided to purchasing system 17 based on prior product purchases."

Thus, Banks discloses an e-catalog system that sends updated pricing information to the purchasing system, which upon matching information received with corresponding items provides prior product purchase data back to the e-catalog system. The e-catalog system then uses the history data to recalculate the price and identifies any incorrect pricing. Instead of using a mapping database record that comprises a quote amount and a desired quantity to calculate an order price, Banks uses prior product purchase data to recalculate the price. In fact, Banks does not mention anything about a quote amount from a quotation database or a desired quantity from a product manufacturing facility order.

In paragraph 28, Banks merely discloses that "purchasing system 17 uses the updated product information to generate a purchase order (item 27 of Fig. 1) for communication in step 215 to a remote application employed by suppliers." Instead of receiving a product manufacturing facility order that identifies at least the first product and desired quantity, Banks generates the purchase order based on the updated product information and sends the order to a remote application of the suppliers. Therefore, Banks could not have disclosed "calculating an order price based on the desired quantity identified in the product manufacturing facility order," as recited in claim 1. Not only does Banks use prior product purchase data instead of a quote amount and a desired quantity to recalculate the price, Banks does not calculate an order price based on a desired quantity identified in the product manufacturing facility order, because Banks

generates a purchase order instead of receiving a product manufacturing facility order. Therefore, Banks does not and would not disclose the features of claim 1, as alleged by the examiner.

Furthermore, the examiner alleges that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Shavit to update a mapping database record associated with the first product with predetermined information from other databases associated with the product, retrieve a mapping database record associated with the product from the mapping database, calculate an order price based on the mapping database record, and create an order using a graphical user interface, as taught by Banks, in order to improve the responsiveness of the system to purchasers and thereby increase commerce using the method. Applicants respectfully disagree.

Instead of calculating an order price based on a mapping database record that comprises a quote amount and desired quantity, Banks discloses recalculating the price based on prior product purchase data. In addition, since Banks discloses generating a purchase order instead of receiving a product manufacturing facility order, Banks could not have calculated an order price based on a desired quantity identified in the product manufacturing facility order. One of ordinary skill in the art at the time of invention would not have been led to modify Shavit's disclosure to calculate an order price based on mapping database record comprising a quote amount and a desired quantity identified in the product manufacturing facility order, because Banks fails to mention either a quote amount from a quotation database or a desired quantity from a product manufacturing facility order, let alone calculating an order price based on the quote amount and the desired quantity.

The examiner states that claims 11, 19, and 26 are rejected based on the same rationale as claim 1. Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection to claims 1-2, 4-12, 14-20, and 22-31 under 35 U.S.C. §103(a) should be withdrawn.

2. The Combination of References is Improper

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why the Shavit and Banks references cannot be applied to reject claims 1-2, 4-12, 14-20, and 22-31 under 35 U.S.C. § 103(a).

§ 2142 of the MPEP also provides:

> *...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither Shavit nor Banks discloses, or even suggests, the desirability of the combination of "calculating an order price based on the mapping database record comprising the quote amount associated with the first product, and the desired quantity identified in the product manufacturing facility order," since neither reference discloses a mapping database record that comprises a quote amount and a desired quantity identified in the product manufacturing facility order. Shavit fails to mention anything about a mapping database. Banks fails to mention anything about a quote amount from a quotation database or a desired quantity identified in a manufacturing facility order that is received. Therefore, there is no disclosure or suggestion in either reference to combine the desired quantity identified in the manufacturing facility order and the quote amount in a mapping database record and calculate an order price based on that record.

Thus, it is clear that neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103(a) rejection.

In this context, the MPEP further provides at § 2143.01:

> *The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

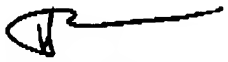
In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 1, 11, 19, and 26. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection to claims 1-2, 4-12, 14-20, and 22-31 under 35 U.S.C. §103(a) should be withdrawn.

Conclusion

It is clear from all of the foregoing that independent claims 1, 11, 19 and 26 are in condition for allowance. Dependent claims 2, 4-10, 12, 14-18, 20, and 22-25, and 27-34 depend from and further limit independent claims 1, 11, 19 and 26 and therefore are allowable as well.

An early formal notice of allowance of claims 1-2, 4-12, 14-20, and 22-34 is requested.

Respectfully submitted,



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